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IN THE

Supreme Court of the United States

OCTOBER TERM, 1943.

No. 136

CONRAD E. LANGFIELD, DOING BUSINESS AS THE SOLVITE COMPANY,

Petitioner,

vs.

SOLVENTOL CHEMICAL PRODUCTS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

TO THE HONORABLE, THE CHIEF JUSTICE OF THE UNITED STATES, AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

This is an application on behalf of Conrad E. Langfield of Northville, Michigan, doing business as The Solvite Company, for a writ of certiorari to review a judgment of the Circuit Court of Appeals for the Sixth Circuit, entered on April 6, 1943. This judgment reversed a decree of the District Court for the Eastern District of Michigan, Southern Division (Arthur F. Lederle, District Judge), in favor of the petitioner (Rec. 263 and following).

The opinion of the Circuit Court of Appeals follows page 278 of the record and is reported in 134 F. (2d) 899.

I.

Jurisdiction.

(a) Federal jurisdiction of the courts below exists under the Federal Trade-Mark Act of 1905 (U. S. C. Tit. 15, Sec. 81 and following) and Sec. 4915 R. S. U. S. (U. S. C. Tit. 35, Sec. 63).

(b) The jurisdiction of this court is invoked under Section 240 of the Judicial Code, as amended by Act of Congress of February 13, 1925, 43 Stat. 938; U. S. C. Tit. 28, Sec. 347 (a).

(c) The cases believed to sustain the jurisdiction of this court to grant a Writ of Certiorari in the present case are *Thaddeus Davids* v. *Davids*, 233 U. S. 461, *Armstrong Paint & Varnish Works* v. *Nu-Enamel Corporation*, 305 U. S. 315, and *Mishawaka Rubber & Woolen Manufacturing Co.* v. *S. S. Kresge Co.*, 316 U. S. 203.

II.

The Questions Presented.

The questions here presented involve the construction of the Federal Trade-Mark Act of February 20, 1905 (U. S. C. Tit. 15, Sec. 96), and the right of the owner of a validly registered trade-mark thereunder to be protected against a colorable imitation of it.

III.

Summary and Short Statement of the Matter Involved.

This was an action brought by respondent, Solventol Chemical Products, Inc., under Section 4915 R. S. (35 U. S. C. Sec. 63), seeking judgment authorizing the Commissioner of Patents to register the word Solventol

as a trade-mark for cleaners while petitioner's registered trade-mark Solvite, also for cleaners, was extant. The Commissioner had refused registration to Solventol because of its confusing similarity to petitioner's previously registered and earlier used trade-mark Solvite for the same goods. The authority for the proceeding in the District Court was this court's application to trade-marks of Rev. Stat. Sec. 4915, which in terms deals only with patents (*American Steel Foundries* v. *Robertson,* 262 U. S. 209).

The relevant statutes are in the appendix.

Petitioner counter-claimed for an injunction against the name Solventol as a colorable imitation and an infringement of petitioner's registered trade-mark Solvite. The District Court agreed with the Commissioner of Patents that Solventol was confusingly similar to Solvite, dismissed respondent's bill, and directed an injunction on petitioner's counter-claim. The findings of fact of the District Court are at pages 263-267, of the record. They were not disturbed by the Circuit Court of Appeals. Petitioner's counter-claim averred (Rec. 7) that respondent's alleged trade-mark Solventol is a colorable imitation of petitioner's registered trade-mark Solvite and that the marks are applied to merchandise of substantially the same descriptive properties. This is an allegation of statutory trade-mark infringement. There was no pleading filed by respondent denying the averments of the counter-claim. The two tribunals of the Patent Office where this proceeding originated held that the marks of the parties are confusingly similar. The District Court found as a fact (Rec. 264):

> "The evidence produced in this case fully supports the decisions made by the Patent Office and establishes that the two marks are confusingly similar."

The Circuit Court of Appeals thought that Solvite, the registered trade-mark applied to petitioner's cleaner, was suggestive and not wholly arbitrary. It accordingly

held that Solventol was not confusingly similar to it. In so doing the court imported into the statute a limitation which is not there. The statute defines a trade-mark (U. S. C. Tit. 15, Sec. 108) as including "any mark which is entitled to registration under the terms of this act." Petitioner's mark is entitled to registration and is registered. The statute provides remedies for colorably imitating trade-marks registered under it. No one has questioned the validity of petitioner's registration and under the authority of *Davids* v. *Davids*, 233 U. S. 461, relief should have been given.

The District Court found that there was no evidence which required a conclusion different from that reached by the Patent Office that the marks are confusingly similar but, on the contrary, found that the evidence produced fully supports this conclusion. In these circumstances the decision of this court in *Morgan* v. *Daniels*, 153 U. S. 120, required affirmance. The District Court did this. The reversal by the Circuit Court of Appeals was error.

IV.

Reasons Relied On for the Allowance of the Writ.

1. It is a matter of public importance that trade-marks should be protected against deceptive imitation. The Circuit Court of Appeals has denied petitioner's trade-mark this protection.

2. It is a matter of public importance that statutes designed to protect trade-marks should be applied so as to carry out the purpose of Congress, that the rights conferred on registrants be secured and the remedies against infringement applied.

3. The Federal Trade-mark Statute requires relief against colorable imitation of a registered trade-mark whatever its linguistic derivation and it makes no distinc-

tion between wholly arbitrary and suggestive marks. When registered, such marks are trade-marks and entitled to protection. This right the Circuit Court of Appeals denied petitioner.

4. It is important that the lower Federal Courts observe the express terms of Federal Statutes and not disregard them because they do not happen to conform to the ideas the judges sitting may, at the moment, entertain.

Petitioner asks, therefore, that this court grant a writ of certiorari to the Circuit Court of Appeals for the Sixth Circuit.

Respectfully submitted,

EDWARD S. ROGERS,
WILLIAM T. WOODSON,
SHERWIN A. HILL,
KARL D. LOOS,
Attorneys for Petitioner.

BRIEF IN SUPPORT OF PETITION.

The Opinions Below.

The findings and conclusions of the District Court are at pages 263-268 of the record. The opinion of the Circuit Court of Appeals follows page 278 of the record, and is reported in 134 F. (2d) 899.

Jurisdiction.

The petition sets forth on page 2 the grounds on which jurisdiction is invoked.

Statement of the Case.

The petition sets forth on pages 2 to 4 under the caption "Summary and Short Statement of the Matters Involved," with appropriate references to the record, all that is material to a consideration of the questions presented.

Specification of Errors.

The court is referred to reasons for the allowance of the Writ on pages 4 and 5 of the petition.

ARGUMENT.

The Circuit Court of Appeals concluded that while the goods of the parties are of the same general descriptive properties, confusion will be unlikely to result from the use by respondent of its later adopted mark. The reason for the court's conclusion in its own words is:

> "Neither of the marks in question is of that class known as arbitrary or fanciful. Each falls quite clearly into the class of suggestive marks characteristic of the product exemplified."

The court then goes into a discussion of the derivation of both marks and concludes that the suffixes "vite" and "tol" distinguish one from the other which make "it unlikely that one trade-mark could, with the exercise of ordinary care, be mistaken for or be confused with the other."

As we interpret the Circuit Court of Appeals' opinion, its view is that deceptive similarity must be endured if the mark alleged to be infringed is not wholly arbitrary and meaningless and that, to the degree that suggestiveness enters into the composition of the mark, colorable imitation is legitimate. The requirement of ordinary care on the part of purchasers is not in the statute and seems to be the court's own idea.*

In *Mishawaka Rubber & Woolen Manufacturing Co.* v.

* The law as laid down by this court does not require the exercise of ordinary care on the part of the public.

In *Federal Trade Commission* v. *Standard Education Society*, 302 U. S. 112, 116, Mr. Justice Black said:

> "There is no duty resting upon a citizen to suspect the honesty of those with whom he transacts business. Laws are made to protect the trusting as well as the suspicious. The best element of business has long since decided that honesty should govern competitive enterprises, and that the rule of caveat emptor should not be relied upon to reward fraud and deception."

Federal Trade Commission v. *Royal Milling Company*, 288 U. S. 212, 216, 217.

S. S. Kresge Co., 316 U. S. 203, 205, Mr. Justice Frankfurter, speaking of the Trade-Mark Act of 1905, said:

> "The 'right to be protected against an unwarranted use of the registered mark has been made a statutory right' by that Act. *Thaddeus Davids Co.* v. *Davids Mfg. Co.*, 233 U. S. 461, 471."*

The court below does not recognize the rule announced in the Davids case (233 U. S. 461, 468), that "having the right to register its mark, the complainant was entitled to its protection as a valid trade-mark under the statute. * * * It was not the intent of Congress thus to provide for a barren notice of an ineffectual claim, but to confer definite rights." The Circuit Court of Appeals in this case, we submit, ignored petitioner's statutory right. Holding petitioner's registration valid, it refused to apply the remedy which the statute confers.

One of the rights which the statute gives is the right of the owner of a registered trade-mark to protection against colorable imitation. Not only did the court deny protection against colorable imitation but it implies that this court was wrong in holding (*Thaddeus Davids Co.* v. *Davids*, 233 U. S. 461, 468) that the provision of Section 16 against colorable imitation applies to all trade-marks that are within the Act. It deprived petitioner of the benefit of that provision. In effect, it writes into the statute a limitation which is not in the Act or in the decisions of this court. In fact, petitioner was entitled to the relief the District Court decreed, whether its trade-mark should be regarded as an entirely arbitrary name or one having a remote suggestiveness. The idea that there are gradations in protection was advanced at one time by the Circuit Court of Appeals of the Second Circuit in *Washburn-Crosby Co.* v. *France Milling Co.*, 7 F. (2d) 304. This case was decided in 1925 by Judges Rogers, Hough and Man-

* In the Mishawaka case there was no evidence that the resemblance between the marks caused anyone to buy the goods of one party for those of the other.

ton. The same court composed of Judges Learned Hand, Swan and Chase in 1936 in *Landers, Frary & Clark* v. *Universal Cooler Corporation* (C. C. A. 2), 85 F. (2d) 46, 48, thus states the present law:

> "The suggestion has at times also been made that the doctrine does not apply to a mark which is not coined, and it is on this that the defendant apparently relies. *Pabst Brewing Co.* v. *Decatur Brewing Co.*, 284 F. 110 (C. C. A. 7); *France Milling Co.* v. *Washburn-Crosby Co.*, 7 F. (2d) 304 (C. C. A. 2); *Treager* v. *Gordon-Allen, Ltd.*, 71 F. (2d) 766 (C. C. A. 9). We do not agree; so far as *France* v. *Washburn-Crosby Co., supra*, says anything to the contrary, it was obiter."

The court below seems to have based its decision on a notion now abandoned by the court which first announced it and never accepted by this court which has consistently held the opposite. *Thaddeus Davids* v. *Davids*, 233 U. S. 461, 466, 468, 469, 470; *Armstrong Paint & Varnish Works* v. *Nu-Enamel Corporation*, 305 U. S. 315, 335; *Baglin* v. *Cusenier*, 221 U. S. 580, 600.

The Court of Appeals should have accepted the fact of confusing similarity found by the Patent Office under the rule of law laid down by this court in *Morgan* v. *Daniels*, 153 U. S. 120. In discussing the weight of evidence and effect of a Patent Office decision as to facts in a suit under Section 4915, Mr. Justice Brewer said (125):

> "Upon principle and authority, therefore, it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

In this case both parties took additional evidence. The respondent's consisted merely of the testimony of two detectives who shopped a large number of retail stores

in the City of Detroit. They testified that they did not find the petitioner's product on sale in all these stores (Rec. 36-47). These detectives, however, did find petitioner's product on sale in some of the stores which they visited. This was the only additional testimony that made the record for the respondent in the District Court differ from that in the Patent Office, and it did not strengthen respondent's case. Petitioner, however, produced additional testimony which showed that there was confusion between the trade-marks involved in the minds of retail dealers in the City of Detroit. Therefore, since the petitioner had a stronger case in the District Court than it had in the Patent Office and the District Court sustained the Patent Office, then the Court of Appeals should likewise have sustained the District Court based upon the findings of fact and conclusions of law entered by that court.

The Court of Appeals did not follow the rule of law laid down by this Court in *Morgan* v. *Daniels*, 153 U. S. 120, nor did it comply with Rule 52 of the Federal Rules for Civil Procedure which provides that:

> "Findings of fact shall not be set aside unless clearly erroneous, * * *."

This Court and the various Courts of Appeal have held time and time again that the findings of fact and conclusions of law of a District Court should not be set aside unless clearly erroneous. We submit that there was no error in the District Judge's findings of fact and his conclusions of law and that based upon his findings and conclusions, he entered the proper judgment in enjoining Solventol as an infringement of Solvite and refusing to instruct the Commissioner of Patents to grant registration to Solventol.

Conclusion.

Respondent's brief and argument in the Court of Appeals was a cry for help to save it from the serious fix it found itself in by building up a business under the infringing mark over petitioner's protest and opposition in the Patent Office. That is the same sort of predicament that the appellant was in in *Yale Electric Corporation* v. *Robertson*, (C. C. A. 2), 26 F. (2d) 972. In that case Judge Learned Hand in affirming a decision of the District Court for the District of Connecticut, in dismissing the complaint and sustaining a counterclaim in a 4915 action like this, said (974):

> "The plaintiff has gone on in the face of the defendant's opposition from the very outset. If its persistence now lays a heavy burden on it, it is of its own making. It would be an easy escape from the consequences of a wrong to assert that one has grown so old in its practice as to make any change painful."

We feel that it is of general importance and in the public interest that a judgment which denies protection to a valid registered trade-mark under the Federal Statutes be reviewed and reversed.

Respectfully submitted,

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APPENDIX.

R. S. U. S. 4915.

U. S. C., Tit. 35, § 63, page 224:

§ 63. Bill in equity to obtain patent

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect

as if originally taken and produced in the suit. R. S. § 4915; February 9, 1893, c. 74, § 9, 27 Stat. 436; March 2, 1927, c. 273, § 11, 44 Stat. 1336; March 2, 1929, c. 488, § 2(b), 45 Stat. 1476; August 5, 1939, c. 451, § 4, 53 Stat. 1212.

Federal Trade-Mark Act of 1905.

U. S. C., Tit. 15, § 96, page 232:

§ 96. Evidence of ownership; infringement, and damages therefor

The registration of a trade-mark under the provisions of this subdivision of this chapter shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. Feb. 20, 1905, c. 592, § 16, 33 Stat. 728.

U. S. C., Tit. 15, § 98, page 314:

§ 98. Review by Supreme Court

Writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this subdivision of this chapter in the same manner as provided by section 347 of Title 28, Judicial Code and Judiciary. Feb. 20, 1905, c. 592, § 18, 33 Stat. 729.

U. S. C., Tit. 15, § 99, page 315:

§ 99. Injunctions; recovery and assessment of damages

The several courts vested with jurisdiction of cases arising under this subdivision of this chapter shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under said subdivision, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section 96 of this chapter for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed. Feb. 20, 1905, c. 592, § 19, 33 Stat. 729.

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

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United States of America

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

I.

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED

The petition for writ of certiorari in this cause seeks a review of a decision of the United States Circuit Court of Appeals for the Sixth Circuit, filed April 6, 1943.

In this litigation, Petitioner challenges two rights of Respondent, Solventhol Chemical Products, Inc., as follows:

1. The right of Respondent to register its trade-mark "Solventol" for use on water soluble cleaning compounds. (This issue is presented by a suit brought by Respondent in the District Court under R. S. 4915, 35 U. S. C. 63, seeking a review of a decision of the Commissioner of Patents.)

2. The right of Respondent to continue the use of its trade-mark "Solventol" on water soluble cleaning compounds. (This issue is presented by Petitioner's counterclaim for trade-mark infringement.)

Both rights are challenged in view of Petitioner's prior registration and use of the trade-mark "Solvite" on a dry cleaning soap which is insoluble in water and can only be used in a hydrocarbon dry cleaning fluid.

While two rights are in question, it is obvious that the right of Respondent to continue the use of its trade-mark "Solventol" is by far the more important. The right to register is clearly ancillary to the right to use. Accordingly, this case, in its most important aspect, is an ordinary suit for infringement of a registered trade-mark.

The petition asserts that the Circuit Court of Appeals refused to give effect to the statute (U. S. C. Title 15, Sec. 96, Petition page 14) which prohibits the use of colorable imitations of registered trade-marks. Petitioner attempts to support this position by the assertion that the Circuit Court of Appeals did not disturb the District Court's finding of trade-mark infringement and by the allegation that no pleading was filed by Respondent deny-

ing the averments of the counterclaim for trade-mark infringement. Both of these assertions are erroneous.

The fact is that the Circuit Court of Appeals expressly held there was no infringement and no likelihood of confusion, saying:

> "Taking into consideration the descriptive syllables of the respective trade-marks in question and the differences in the suffixes and the dissimilarity of the goods on which the respective marks are used, we are of the opinion that the registration of the trade-mark 'Solventol' will not be likely to cause confusion or mistake in the minds of the public and that appellant (Respondent) is entitled to have its mark registered." (Rec. 285-286).
>
> * * * * *
>
> "Disregarding the registerability of Appellant's trade-mark, there is no independent evidence in the record that appellant has infringed upon appellee's common law rights or has competed with appellee unfairly, or that appellant has been guilty of unfair trade practices toward appellee." (Rec. 286).

Moreover, an answer to the counterclaim *was* duly filed and served by Respondent, but through an oversight it was not included in the printed record on appeal. The answer to the counterclaim is printed in the appendix of this brief at pages 15-17, and a certified copy is filed herewith. The Docket Entries in the District Court (Rec. 2) show that the Plaintiff's answer to the counterclaim was filed on March 12, 1940, three days after the counterclaim, itself, was filed. Proof of service of the answer to the counterclaim in the form of an affidavit of Robert L. Boynton, one of the attorneys representing Respondent in the

District Court, is also filed herewith, and the affidavit is printed in the appendix at pages 16-17 of this brief.

The fact that a copy of the answer to the counterclaim was not included in the printed record on appeal was not discovered by Respondent's attorneys until the present petition for a writ of certiorari was served. See the affidavit of John A. Blair, filed herewith and printed at pages 17-18 of this brief.

It is not believed that this Court should grant the present petition merely because of the inadvertent failure to include Plaintiff's answer to Defendant's counterclaim in the printed record, particularly in view of the fact that Petitioner has not previously challenged the sufficiency of the pleadings or the record; and evidence controverting the allegations of the counterclaim was offered and received without objection in the District Court (Federal Rules of Civil Procedure, 15(b)). If the petition is not granted there will be no need to correct the record and, accordingly, Respondent proposes to await the Court's decision on the petition before filing a petition under Rule 17 of this Court to correct diminution of the record.

There remains then, as the only issue in the case, the question of whether or not the Respondent's trade-mark is a colorable imitation of Petitioner's mark. That question is a fact question decided adversely to Petitioner by the Circuit Court of Appeals and not such a question as would justify this Court in granting the writ.

Petitioner complains that the Court of Appeals, in deciding that question, was influenced by the fact that the only common feature of the two marks (the syllable

"Solv") was not distinctive but, on the contrary, was suggestive of the nature of the goods and in common use on such goods. That such is the fact is amply established by evidence that many concerns, both before and since the first use of Petitioner's mark, have employed on cleaning compounds trade-marks beginning with the syllable "Solv." (Rec. 87, 176-183, and Plaintiff's Exhibits 46-64, inclusive, Rec. 242-261.) As hereinafter pointed out, that circumstance, while not conclusive, is universally regarded as one that must be taken into consideration in weighing the question of trade-mark infringement.

The evidence establishes the existence of many other facts negativing likelihood of confusion in the trade and, therefore, negativing infringement. Among them may be mentioned the following:

1. The trade-marks as a whole ("Solventol" and "Solvite") are materially different. (Compare Plaintiff's Exhibit 2, Rec. 132-133, with Plaintiff's Exhibit 7, Rec. 219.)

2. The goods on which the marks are used are different and non-competitive. Petitioner's trade-mark is registered for use and is used only on a dry cleaning soap which can only be used in gasoline or naphtha for dry cleaning operations, while Respondent's goods can only be used in water for ordinary washing operations. (Plaintiff's Exhibit 7, Rec. 219 and Rec. 206-215.)

3. Petitioner's dry cleaning soap is sold at retail only in drug stores (Rec. 36-37 and Plaintiff's Exhibits 34 and 35, Rec. 227), while less than two-tenths of one per cent of Respondent's cleaner has been sold in drug stores (Plaintiff's Exhibit 36, Rec. 228).

4. The dress of the goods is entirely different. (Compare Plaintiff's physical Exhibits 8 and 40.*)

5. Petitioner's business is almost non-existent, amounting to less than One Thousand Dollars per year, and hence the reputation of his trade-mark is limited compared with that of Respondent. (See Findings of Fact No. 9 of District Court, Rec. 265, and opinion of Circuit Court of Appeals, Rec. 281-282, which are based on Defendant's answers to Plaintiff's Interrogatories, Rec. 11-33, and Plaintiff's Exhibit 36, Rec. 228.)

These are all matters of fact that entered into the Circuit Court of Appeals decision of the ultimate fact question of likelihood of confusion.

II.

SUMMARY OF ARGUMENT

The Trade-Mark Act of February 20, 1905 (Title 15, Sec. 96, U. S. C.), in so far as it prohibits the use of "colorable" imitations of registered trade-marks, merely prohibits such imitation as is calculated to mislead the public with respect to the origin of the goods.

American Steel Foundries v. Robertson, 269 U. S. 372, 381; 70 L. Ed. 317, 321.

Armstrong Paint and Varnish Works v. Nu-Enamel Corp., 305 U. S. 315, 335; 83 L. Ed. 195, 207.

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*Specimens of the containers in which the goods of the respective parties are sold are transmitted herewith. They correspond to Plaintiff's physical Exhibits 8 and 40, which are in the possession of the Circuit Court of Appeals. Plaintiffs Exhibit 40 is Respondent's smallest size container. The other containers of Respondent differ only in size.

Thaddeus Davids Co. v. Davids, 233 U. S. 461, 470; 58 L. Ed. 1046, 1050.

The question of whether or not Respondent's mark is calculated to mislead the public is a fact question decided adversely to Petitioner by the Circuit Court of Appeals, and certiorari is not granted merely to review evidence or inferences drawn therefrom.

General Talking Pictures Corp. v. Western Electric Co., Inc., 304 U. S. 175, 178; 82 L. Ed. 1273, 1275.

Southern Power Company v. North Carolina Public Service Company, 263 U. S. 508, 509; 68 L. Ed. 413.

Magnum Import Co. v. De Spoturno Coty, 262 U. S. 159, 163; 67 L. Ed. 922, 924.

In deciding the single question presented, the Circuit Court of Appeals properly took into consideration, along with other facts, the non-distinctive character of the only feature common to the trade-marks of the parties.

American Steel Foundries v. Robertson, 269 U. S. 372, 382-384; 70 L. Ed. 317, 321-322.

Pabst Brewing Co. v. Decatur Brewing Co. et al., 284 F. 110 (CCA 7).

Burger Brewing Co. v. Maloney-Davidson Co. et al., 86 F. (2d) 815 (CCA 6).

Valvoline Oil Co. v. Havoline Oil Co., et al., 211 F. 189 (D. C. S. D. N.Y.).

Arrow Distilleries, Inc., v. Globe Brewing Co., 117 F. (2d) 347 (CCA 4).

Thomas Kerfoot & Co., Ltd., v. Louis K. Liggett Co., 67 F. (2d) 214 (CCA 1).

Herman Nelson Corp v. Columbus Heating & Ventilating Co., 11 F. (2d) 273, 277 (CCA 6).

Restatement of the Law of Torts, Chapter 35, Sec. 729, comment g; Chapter 35, Sec. 733, comment b.

The rule of *Morgan v. Daniels,* 153 U. S. 120, 125, to the effect that decisions of the Patent Office must be accepted as controlling unless the contrary is established by evidence which carries thorough conviction, has no bearing upon the issue of trade-mark infringement, and it was not violated by the Circuit Court of Appeals decision holding Respondent's trade-mark registerable.

California Packing Corp. v. Tillman & Bendel, Inc., 40 F. (2d) 108, 113 (CCPA).

Goodrich Co. v. Kenilworth Mfg Co., Inc., 40 F. (2d) 121, 122 (CCPA).

No new or important question is involved and there is presented no conflict with decisions of this Court or between decisions of the Circuit Courts of Appeal of different circuits.

III.

ARGUMENT

The Trade-Mark Act of February 20, 1905, in so far as it seeks to define substantive rights, is simply an expression of the common law. *American Steel Foundries v. Robertson,* 269 U. S. 372, 381; 70 L. Ed. 317, 321. Accordingly, U. S. C. Title 15, Section 96 (Petition page 14), in prohibiting the use of "colorable" imitations of registered trade-marks, has been construed to prohibit only the use of such marks as will be likely to cause confusion in the trade. In *Armstrong Paint and Varnish Works v. Nu-Enamel Corp.,* 305 U. S. 315, 335; 83 L. Ed. 195, 207, this court, in discussing what it described as

"substantially the same" provision in the Trade-Mark Act of March 19, 1920 (U. S. C. Title 15, Section 124*), said:

> "As was pointed out in the Davids case, in considering the ten year clause of the 1905 Act, this right (provided in U. S. C. Title 15, Section 124) of freedom does not confer a monopoly on the use of words. It is a mere protection against their unfair use as a trade-mark or a trade-name by a competitor seeking to palm off his products as those of the original user of the trade-name."

In the Davids case (*Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 470; 58 L. Ed. 1046), the court said, in discussing the scope of protection afforded the owner of a trade-mark registered under the Act of 1905:

> "* * * the reproduction, copy or imitation which constitutes infringement must be such as is calculated to mislead the public with respect to the origin or ownership of the goods, and thus to invade the right of the registrant to the use of the name or terms as a designation of his merchandise."

It is exactly that question which was decided adversely to Petitioner by the Circuit Court of Appeals after a consideration of all the facts and circumstances established by the evidence. The question is one of fact, and certiorari is not granted merely to review facts. In *General Talking Pictures Corp. v. Western Electric Company, Inc.*, 304 U. S. 175, 178; 82 L. Ed. 1273, 1275, the Court said:

> "Granting of a writ would not be warranted merely to review the evidence of inferences drawn from it."

*See appendix, page 19 of this brief.

See, also, *Southern Power Company v. North Carolina Public Service Company,* 263 U. S. 508, 509; 68 L. Ed. 413; *Magnum Import Co. v. De Spoturno Coty,* 262 U. S. 159, 163; 67 L. Ed. 922, 924.

The Circuit Court of Appeals, in deciding this fact question, properly considered, among other evidence, that the only common feature of the trade-marks of the parties was a non-distinctive and suggestive syllable. This and other courts have uniformly held that circumstance has an important bearing upon the scope of protection to which a trade-mark owner is entitled.

American Steel Foundries v. Robertson, 269 U. S. 372, 383-384; 70 L. Ed. 317, 321-322.

Pabst Brewing Co. v. Decatur Brewing Co. et al., 284 F. 110 (CCA 7).

Burger Brewing Co. v. Maloney-Davidson Co. et al., 86 F. (2d) 815 (CCA 6).

Valvoline Oil Co. v. Havoline Oil Co., et al., 211 F. 189 (D. C. S. D. N. Y.).

Arrow Distilleries, Inc. v. Globe Brewing Co., 117 F. (2d) 347 (CCA 4).

Thomas Kerfoot & Co., Ltd. v. Louis K. Liggett Co., 67 F. (2d) 214 (CCA 1).

Herman Nelson Corp. v. Columbus Heating & Ventilating Co., 11 F. (2d) 273, 277 (CCA 6).

The *Restatement of the Law of Torts,* Chapter 35, states the rule as follows:

> "Not all trade-marks are equally effective in sales stimulation. Some are effective because they are unique, as, for example, Kodak; others are less effective because common, as, for example, Simplex or Blue Ribbon. The greater the number of identical or more or less similar trade-marks

> already in use on different kinds of goods, the less is the likelihood of confusion, apart from the other factors mentioned in this section." (Section 729, comment g.)
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> * * * * *
>
> "Failure by the prior user of a trade-mark or trade-name to take effective steps to prevent subsequent use of a similar designation by another may narrow the class of goods or the territorial markets with reference to which his priority would otherwise entitle him to exclude others." (Section 733, comment b.).

The petition asserts that the above stated rule was abandoned by the Second Circuit Court of Appeals in the case of *Landers, Frary & Clark v. Universal Cooler Corp.*, 85 F. (2d) 46, 48, involving the trade-mark "Universal". This statement is erroneous and the excerpt in the petition (page 9) is misleading and incomplete. The court actually stated the rule with approval and merely pointed out that lack of distinctiveness was not conclusive against the owner of the non-distinctive mark. Thus, following the quotation appearing in the petition, the court said:

> "The proprietary connotation, — 'secondary meaning',—of a word of common speech is harder to create and easier to lose, and its fringe or penumbra does not usually extend so far as that of a coined word. But that is a matter of proof and proof alone; if the owner can in fact show that the fringe does extend to other goods there is no reason why his interest should not be recognized."

In the instant case, there is no evidence as to the extent that the trade-mark "Solvite" is associated in the public mind with Petitioner and all the evidence strongly indi-

cates that it can have only a most limited reputation in the limited field of dry cleaning soaps. The reputation, if any, attached to Petitioner's mark cannot possibly extend to the distinctly different field of water soluble cleaners, let alone engulf a different mark in that field. No confusion in the trade with respect to the source of Respondent's goods was shown even after many years use of Respondent's mark in the same territories in which Petitioner did business.

The Petitioner asserts (Petition page 9) that the Circuit Court of Appeals should have accepted the fact of confusing similarity found by the Patent Office under the rule of *Morgan v. Daniels,* 153 U. S. 120. However, the Circuit Court of Appeals recognized that Respondent, in so far as the issue of registration was concerned, had sustained the burden imposed by the case of *Morgan v. Daniels* by adducing new evidence at the trial in the District Court. This is clear since the Circuit Court of Appeals, in its opinion, referred to the rule of *Morgan v. Daniels* and recited some of the facts established by the new evidence.*

Moreover, the primary issue in this case is the issue respecting Respondent's right to continue the *use* of its trade-mark. *Morgan v. Daniels* has no application to that issue because the Commissioner of Patents in trade-mark opposition proceedings has no jurisdiction over and is not interested in the question of trade-mark infringement. This is clearly indicated by the decisions of the Court

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*The evidence of shoppers who called on three hundred stores in Detroit, Michigan, without encountering any confusion, the evidence respecting the relative sizes of the business of the parties and the evidence of the widespread use on cleaning compounds of trade-marks beginning with the syllable "Solv", all of which was referred to by the Circuit Court of Appeals, was evidence not before the Commissioner of Patents. There was other new evidence introduced in the District Court.

of Customs and Patent Appeals, which has appellate jurisdiction over the Commissioner of Patents in trade-mark registration proceedings (including oppositions and cancellations). Thus that court, in *California Packing Corp. v. Tillman & Bendel, Inc.*, 40 F. (2d) 108, 113 (CCPA), said:

> "We are only concerned in this action (an opposition proceeding) with appellee's right of *registration* of the trade-mark and not with its *use* of the same. As to whether appellee, in law, has the right to use the trade-name 'Del Monte' on coffee in containers of any description, or whether it has the right to use it in markets confined to the West Coast or throughout the world, are questions not before us and are not decided."

To the same effect is that court's decision in *Goodrich Co. v. Kenilworth Mfg. Co., Inc.*, 40 F. (2d) 121, 122.

CONCLUSION

In all essential aspects, this case is an ordinary case presenting the question of trade-mark infringement. The only issue in the case is a fact question decided by the Circuit Court of Appeals with due regard to well established principles of law. There is presented no new or important question and there exists no conflict between the decision of the Circuit Court of Appeals in this case and the decisions of the Supreme Court or other Circuit Courts of Appeal.

Under the circumstances, no ground appears for granting the petition and it is respectfully submitted that it should be denied.

ARTHUR W. DICKEY,
JOHN A. BLAIR,
Counsel for Respondent.

APPENDIX

IN THE

DISTRICT COURT OF THE UNITED STATES
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Solventol Chemical Products, Inc., Plaintiff, v. Conrad E. Langfield, doing business as The Solvite Company, Defendant.	Civil Case No. 1676

PLAINTIFF'S ANSWER TO DEFENDANT'S COUNTERCLAIM

1. Plaintiff admits the allegations of Paragraph 1 of Defendant's counterclaim.

2. Plaintiff admits the allegations of Paragraph 2 of Defendant's counterclaim.

3. Plaintiff admits the allegations of Paragraph 3 of Defendant's counterclaim.

4. Plaintiff alleges that it is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of Defendant's counterclaim.

5. Plaintiff admits that on June 12, 1928, the trademark "Solvite" was registered in the name of Conrad E. Langfield, but Plaintiff alleges that it is without knowledge or information sufficient to form a belief as to the

truth of the remaining allegations of Paragraph 5 of Defendant's counterclaim.

6. Plaintiff denies the allegations of Paragraph 6 of Defendant's counterclaim.

7. Plaintiff denies the allegations of Paragraph 7 of Defendant's counterclaim.

8. Plaintiff admits that its goods bearing the trademark "Solventol" are sold in interstate commerce, but Plaintiff alleges that it is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 8 of Defendant's counterclaim.

Wherefore, Plaintiff prays that Defendant's counterclaim herein be dismissed without costs to Plaintiff.

John A. Blair
Harness, Dickey & Pierce,
Attorneys for Plaintiff, Solventol Chemical Products, Inc.

7-141 General Motors Building,
Detroit, Michigan.
March 11, 1940.

JAB:LL

PROOF OF SERVICE

State of Michigan,
County of Wayne—ss.

Robert L. Boynton, being duly sworn, deposes and says that he is an attorney admitted to practice before the courts of the State of Michigan and that he was associated with John A. Blair, of the firm of Harness, Dickey & Pierce, 7-141 General Motors Building, Detroit,

Michigan, in the trial of the case of Solventol Chemical Products, Inc. v. Conrad E. Langfield, Civil Action No. 1676, in the United States District Court for the Eastern District of Michigan, Southern Division; that on March 12, 1940 he personally served a copy of Plaintiff's answer to Defendant's counterclaim upon the firm of Hill, Hamblen, Essery & Lewis, 2282 Union Guardian Building, attorneys for Conrad E. Langfield in the said suit, and that he has refreshed his recollection regarding the personal service of said answer to the counterclaim by reference to his contemporaneous time records in which he records, in the usual course of business, the time spent performing all legal services, the name of the client for whom the services were performed and the date upon which said services were performed.

Further Affiant sayeth not.

/s/ Robert L. Boynton.

Sworn to and subscribed before me this 16th day of July, 1943.

/s/ Lois Elaine Linn,
Notary Public, Wayne County, Michigan.
My Commission expires: March 25, 1946.

(Seal)

AFFIDAVIT

State of Michigan,
County of Wayne—ss.

John A. Blair, being duly sworn, deposes and says that he is a member of the Bar of the State of Michigan and attorney for Solventol Chemical Products, Inc. in the case of Solventol Chemical Products, Inc. v. Conrad E. Langfield, doing business as The Solvite Company,

Civil Action No. 1676, in the District Court of the United States for the Eastern District of Michigan, Southern Division; that he represented Appellant, Solventol Chemical Products, Inc., in an appeal from that case to the Circuit Court of Appeals for the Sixth Circuit; that at no time during the proceedings in the District Court or the Circuit Court of Appeals was any question raised by attorneys for Conrad E. Langfield regarding the sufficiency of the pleadings on behalf of Solventol Chemical Products, Inc.; that Affiant, in preparing the record of appeal, inadvertently omitted to include therein the answer to the Defendant's counterclaim filed and served in the District Court on March 12, 1940; and that this omission was not discovered by Affiant until he received a petition for writ of certiorari to the Supreme Court of the United States filed in the case by Conrad E. Langfield.

Further Affiant sayeth not.

/s/ John A. Blair.

Sworn to and subscribed before me this 16th day of July, 1943.

/s/ Lois Elaine Linn,
Notary Public, Wayne County, Michigan.
My Commission expires: March 25, 1946.

(Seal)

§124. Liability for using another's trade-mark.

Any person who shall without the consent of the owner thereof reproduce, counterfeit, copy, or colorably imitate any trade-mark on the register provided by this subdivision of this chapter, and shall affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. Mar. 19, 1920, c. 104, §4, 41 Stat. 534.